

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Atty. Docket No.: **ASAIN0058**
)
Munehiro DATE et al.) Confirmation No. 4034
)
Serial No. 09/434,498) Group Art Unit: 1774
)
Filed: November 5, 1999) Examiner: HESS, Bruce H.
)
For: REVERSIBLE HEAT-SENSITIVE) Date: October 12, 2006
PAPER AND METHODS FOR)
WRITING INFORMATION)

**REQUEST (H) FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
DETERMINATION**

MAIL STOP: Issue Fee

United States Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Determination of Patent Term Extension under 35 U.S.C. § 154(b), mailed July 12, 2006, a copy of which is attached herewith as "Exhibit A," Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA), calculated by the United States Patent and Trademark Office (USPTO) for the above-identified application, under 37 C.F.R. § 1.705(b) for the following reasons.

(i) First, the fee set forth in 37 C.F.R. § 1.18(e) is attached herewith. It is believed that the present Request for Reconsideration of Patent Term Adjustment Determination complies with the requirements of 37 C.F.R. § 1.705(b), but the Director is hereby authorized to charge any additional fees to Deposit Account No. 50-1281.

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(ii) Second, Applicants proffer the following "Statement of Facts" involved.

Statement of Facts

The Determination of Patent Term Extension under 35 U.S.C. § 154(b), mailed July 12, 2006, states a PTA for the above-captioned application of “0 day(s).” (See Exhibit A). Applicants disagree, and contend that the PTA should be 776 days based in the following facts. The above-captioned application was filed on November 5, 1999 and the first Office Action on the merits was mailed March 3, 2001. The 14-month time period, set forth in 37 C.F.R. § 1.703(a)(1), for issuance of the first office action expired on January 5, 2001. Therefore, the above-captioned application is entitled to an additional PTA of 57 days.

Applicants filed Amendment (A) on June 20, 2001, and a second Office Action was issued by the USPTO on August 29, 2001. Applicants filed Amendment (B) on October 1, 2001, and a third Office Action was issued by the USPTO on April 2, 2002. However, the 4-month time period, set forth in 37 C.F.R. § 1.703(a)(2), for issuance of the third Office Action, based on the date of filing of Amendment (B), expired on February 1, 2002. Therefore, the above-captioned application is entitled to an additional PTA of 60 days.

Applicants filed Amendment (C) on September 25, 2002, and a fourth Office Action was issued by the USPTO on December 10, 2002. Applicants filed Amendment (D) on April 1, 2003, and a fifth Office Action was issued by the USPTO on May 23, 2003.

Applicants then filed Amendment (E) on August 25, 2003, and a first Notice of Allowance was issued by the USPTO on November 19, 2003. Applicants paid the issue fee on February 10, 2004. Subsequently, on September 10, 2004, the USPTO issued a seventh and non-final Office Action withdrawing the Notice of Allowance. Applicants contend that, pursuant to 37 C.F.R. § 1.703(a)(2), the 4-month time period for the USPTO to issue an Office Action or a Notice of Allowance in response to the filing of Amendment (E) expired on December 25, 2003. Applicants further contend that because the first Notice of Allowance was withdrawn by the USPTO, it was

defective and the first Notice of Allowance should not count for the purposes of determining PTA. Instead, Applicants contend that the PTA should be determined using the time period between the filing of Amendment (E), on August 25, 2003, and the mailing of the seventh non-final Office Action on September 10, 2004. Based on these facts, Applicants contend that the above-captioned application is entitled to an additional PTA of 382 days.

Applicants then filed Amendment (F) on November 24, 2004, and the USPTO issued an eighth Office Action on February 8, 2005. Subsequently, Applicants filed Amendment (G) on June 8, 2005, and the USPTO issued a second Notice of Allowance on July 12, 2006. However, the 4-month time period for the USPTO to issue an Office Action or a Notice of Allowance in response to the filing of Amendment (G) expired on October 8, 2005. Therefore, above-captioned application is entitled to an additional PTA of 277 days.

In sum, based on the facts discussed above, the above-captioned application is entitled to a PTA of $57 + 60 + 382 + 277 = 776$ days.

- (iii) The above-captioned application is not subject to any terminal disclaimer.
- (iv) Applicants believe there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-captioned application as set forth in 37 C.F.R. § 1.704.


CONCLUSION

With this paper Applicants have satisfied the requirements of 37 C.F.R. § 1.705(b)(i)-(iv) and proffered sufficient facts to show that the above-captioned application is entitled to a PTA of 776 days and not 0 days.

Questions are welcomed by the below-signed attorney for Applicants.

Respectfully submitted,

GRIFFIN & SZIPL, PC



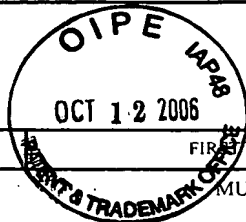
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,498	11/05/1999	MUNEHIRO DATE	ASAIN0058	4034

113 7590 07/12/2006

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EXAMINER	
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ART UNIT	PAPER NUMBER
1774	
DATE MAILED: 07/12/2006	

Determination of Patent Term Extension under 35 U.S.C. 154 (b)

(application filed after June 7, 1995 but prior to May 29, 2000)

The Patent Term Extension is 0 day(s). Any patent to issue from the above-identified application will include an indication of the 0 day extension on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Extension is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

Exhibit A